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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,890	06/29/2001	Juha Salo	004770.00775	4950

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BANNER & WITCOFF
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SUITE 1100
WASHINGTON, DC 20001

EXAMINER

NGUYEN, DAVID Q

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/893,890

Applicant(s)

SALO ET AL.

Examiner

David Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 18-21 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18-21 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 08/02/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

2. Applicant's arguments, see Appeal Brief, filed 08/02/06, with respect to claims 1-10, 18-21 and 38-40 have been fully considered and are persuasive. The previous final rejection of claims 1-10, 18-21 and 38-40 has been withdrawn.

Claim Rejections - 35 USC § 112

3. Claims 1, 18 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. The subject matter “the mobile terminal determines a receiving schedule of the first receiver based on the complementary information” was not described in the specification of the application.

As described in paragraph 0024 of the application’s specification, a scheduled time has been established for the broadcast of the video clip, a service announcement is sent by the cellular network 274 to the cellular transceiver 206. The service announcement is received by the cellular transceiver 206 and is processed by the controller 204.

The specification only mentions the complementary information comprises an announcement relating to the communication service and sending the announcement to the mobile terminal. The specification does not describe: “the mobile terminal determines a receiving schedule of the first receiver based on the complementary information”, as claimed in claims 1, 18 and 38.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8, and 10,18-21, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Tegler et al. (US 6,606,481 B1).

Regarding claims 1, Tegler discloses a mobile terminal (see fig. 1; cellular phone) having a first receiver for receiving a first signal from a first communications network including a communication service comprising: a second receiver within said mobile terminal for receiving a second signal (fig. 1; cellular signal) conveying complementary information relating to the communication service included in said first signal from a second communications network (see col. 3, lines 34-42; the second network: cellular network) and said complementary information comprises an announcement relating to the communication service or an announcement relating to a schedule of communication service (see col. 3, lines 47-53; data broadcast which makes possible for the set-top-box to find data information in the broadcast channel).

Regarding claims 2-3,5-8 and 10, Tegler also discloses a controller for configuring said first receiver according to said complementary information (see col. 3, lines 34-42); wherein said first receiver is enabled to receive said first signal in response to said complementary information (see col. 3, lines 34-42); storage means for storing user preferences (fig. 2; SIM card); decision means for deciding whether said second signal should enable said first receiver in dependence on the stored user preferences (see col. 3, line 60 to col. 4, line 5); wherein said first signal is a digital video broadcasting signal, and said first receiver is a digital video broadcasting receiver (see fig. 2 and col. 3, lines 25-59); wherein said second signal is a global system for mobile signal, and said second receiver is a global system for mobile receiver (see fig. 2 and col. 3, lines

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25-59); wherein the first signal includes a data file, said terminal being actuable in response to said complementary information to receive said data file (see fig. 2 and col. 3, lines 25-59).

Regarding claim 4, Tegler's terminal also mentions wherein said complementary information comprises configuration data for configuring the first receiver (see fig. 2 and col. 3, line 25 to col. 4, line 5).

Regarding claims 18-21, Tegler also discloses a method of receiving a first signal by a mobile terminal from a first communications network including a communication service (see explanation in claim 1) comprising: receiving a second signal with said mobile terminal conveying complementary information relating to the communication service included in said first signal transmitted from a second communications network (see explanation in claim 1) and said complementary information comprises an announcement relating to the communication service or an announcement relating to a schedule of communication service (see explanation in claim 1); receiving said first signal in accordance with said complementary information (see explanation in claim 2); storing user preferences (see explanation in claim 5); deciding whether said second signal should be received in dependence on said stored user preferences (see explanation in claim 6).

Regarding claim 38, Tegler also discloses a method of receiving a first signal with a mobile terminal transmitted from a first communications network including a communication service comprising receiving a second signal conveying complementary information relating to the communication service included in said first signal from a second communications network, (see explanation in claims 1 and 18) and said complementary information comprises an announcement relating to the communication service or an announcement relating to a schedule

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of communication service (see explanation in claims 1 and 18), and combining said information from said second signal with content in said first signal (see fig. 2 and col. 3, line 25 to col. 4, line 5).

Regarding claim 39, Tegler also discloses said complementary information comprises personal data, said data being combined with generic data forming said content of said first signal (see fig. 2 and col. 3, line 25 to col. 4, line 5).

Regarding claim 40, Tegler's method mentions wherein said second signal further comprises configuration data relating to said first signal identifying said content (see fig. 2 and col. 3, line 25 to col. 4, line 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tegler et al. (US 6,606,481 B1) in view of Yuen (WO 00/18123).

Regarding claim 9, Tegler's terminal does not mention said second signal is a general packet radio service signal, and said second receiver is a general packet radio service receiver. However, Yuen discloses said second signal is a general packet radio service signal, and said second receiver is a general packet radio service receiver (see abstract; page 4, lines 4-30 and fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to provide the above teaching of Yuen to Tegler et al so that user can view images on the mobile phone.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

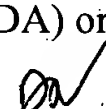
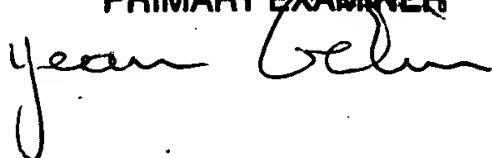
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEAN GELIN
PRIMARY EXAMINER



David Q Nguyen
Examiner
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